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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,695	07/16/2004	Tatsuhiko Suzuki	OOCL-163 (PC-P1780US	6636
26479	7590	11/14/2005	EXAMINER	
STRAUB & POKOTYLO 620 TINTON AVENUE BLDG. B, 2ND FLOOR TINTON FALLS, NJ 07724			SMITH, PHILIP ROBERT	
			ART UNIT	PAPER NUMBER
			3739	

DATE MAILED: 11/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

T21m

Office Action Summary	Application No.		Applicant(s)	
	10/501,695		SUZUKI, TATSUHIKO	
	Examiner		Art Unit	
	Philip R. Smith		3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

[01] Claim 5-6 recite "a switch," which has precedence in claim 1.

Claim Rejections - 35 U.S.C. 112, Paragraph Two

[02] The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

[03] Claims 4-6 & 8-9 recite the "restriction" of the "process." There is insufficient antecedent basis for this limitation in the claim. In accordance with claim 1, as amended, it is not the claimed "processing" which is restricted, but the "instruction, from the switch, input by the user" (lines 16-17).

Claim Rejections - 35 USC § 102

[04] The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

[05] Claims rejected under 35 U.S.C. 102(b) as being anticipated by Kobayashi (6,491,628).

[06] With regard to claims 1 & 10: Kobayashi discloses an electronic endoscope system comprising:

[06a] an endoscope ("video-scope 10," 5/13) having a solid-state imaging device ("CCD 12," 5/35);

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- [06b] a signal processing unit ("image transforming circuit 17 including a CCD driver 16," 5/59-60) which receives a signal from the solid-state imaging device and converts the signal into a video signal;
 - [06c] a detector (composing "system control circuit 34," 6/55-58) provided in the signal processing unit, the detector detecting the type of the solid-state imaging device ("data associated with a type of video-scope 10, such as pixel number and the pixel array," 6/52-55; "data associated with the image area NA and pixel array data of the CCD 12," 6/63-65) which sends (from "EEPROM 15," 6/52) the signal to the signal processing unit;
 - [06d] a switch ("keyboard 51" comprising "'51U," "51D," "51R" & "51L," 7/3-7) for accepting a user input ("position data of the pointer P to be shifted," 7/8) to instruct signal processing by the signal processing unit, the switch being provided in the electronic endoscope system; and
 - [06e] a restricting portion (further composing "system control circuit 34") for restricting the instruction, from the switch, input by a user ("the position of the pointer P is controlled by the system control circuit 34 so that the pointer P is not moved outside the image-area NA," 7/29-31) according to the result detecting performed by the detector ("size of the image area NA," 6/61), the restricting portion being provided in the electronic endoscope system.
- [07] With regard to claim 4: Kobayashi discloses that the restricting unit that restricts instruction restricts a selective item ("pointer P") to be contained in a setting screen image ("image area NA") that helps a user determine settings for the processing to

be performed by the signal processing unit.

- [08] With regard to claims 5-6: Kobayashi discloses that the restricting unit that restricts instruction restricts handling of the switch ("keyboard 51," noted above) on the front panel or keyboard of the signal processing unit.
- [09] With regard to claim 7: Kobayashi discloses that the processing to be performed by the signal processing unit is electronic zooming ("electronic magnifying process," 2/14).
- [10] With regard to claim 8: Kobayashi discloses that the restricting unit restricts indication of a feature ("pointer P") that achieves the restriction.
- [11] With regard to claim 9: Kobayashi discloses that the processing to be restricted is enlargement based on electronic zooming, and the presentation of an electronic zooming magnification is restricted. For example, Kobayashi discloses that "pointer P" is restricted to "image area NA"; and furthermore that "pointer P becomes the center of the magnified image" (7/18-19).

Claim Rejections - 35 USC § 103

- [12] The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
- [13] Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi.
- [14] The signal processing unit disclosed by Kobayashi is inherently capable of implementing basic features and performing extension processing on the image signal.

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- [15] Kobayashi discloses the claimed invention except for a "main board" delineated from an "expansion board," which compose the disclosed signal processing unit. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct a signal processing unit with a "main board" and an "expansion board," since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.
- [16] A skilled artisan might be motivated to provide extension processing on an expansion board separate from the main board in order to provide specialized extension processing for individual apparatuses.
- [17] The signal processing unit disclosed by Kobayashi is inherently capable of "detecting" its component parts.

Response to Arguments

- [18] Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

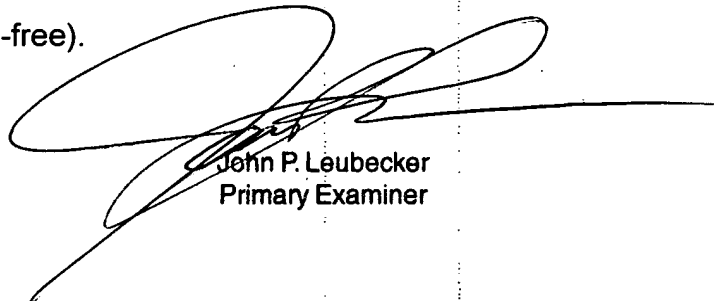
- [19] Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
- [20] A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

[21] Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip R. Smith whose telephone number is (571) 272 6087 and whose email address is philip.smith@uspto.gov. The examiner can normally be reached between 9:00am and 5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272 4764.

[22] Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

prs



John P. Leubecker
Primary Examiner